

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Benny et al.	:	Osman, Ramy M.
	:	
Serial No.: 09/876,090	:	Group Art Unit: 2157
	:	
Filing Date: June 7, 2001	:	
	:	
Title: ENTERPRISE SERVICE	:	IBM Corporation
DELIVERY TECHNICAL	:	Intellectual Property Law
FRAMEWORK	:	11400 Burnet Road
	:	Austin, Texas 78758
	:	

**AMENDED APPEAL BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**I. REAL PARTY IN INTEREST**

The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

Claims 22-25 are pending in the Application. Claims 1-21 were previously cancelled. Claims 22-25 stand rejected. Claims 22-25 are appealed.

#### IV. STATUS OF AMENDMENTS

Appellants have not submitted any amendments following receipt of the final office action with a mailing date of January 11, 2007.

#### V. SUMMARY OF CLAIMED SUBJECT MATTER

##### Independent Claim 22:

In one embodiment of the present invention, a method for creating a technical framework for use in delivering a specific set of information technology services for a customer comprises the step of determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services. Specification, page 30, lines 19-23; Specification, page 31, lines 18-23; Specification, page 32, lines 3-7; Figure 2, step 202. The method further comprises mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities. Specification, page 23, line 22 – page 24, line 5; Specification, page 24, lines 9-16; Specification, page 30, lines 13-16; Specification, page 32, lines 12-23; Figure 2, step 204; Figure 3, elements 301, 308. The method further comprises creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components. Specification, page 33, lines 1-4; Specification, page 33, line 16 – page 34, line 2; Figure 2, step 205. The method further comprises designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer. Specification, page 33, lines 1-7; Figure 2, step 205.

Independent Claim 23:

In one embodiment of the present invention, a technical framework for use in delivering a specific set of information technology services for a customer, comprises the step of a solution scope determined for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services. Specification, page 30, lines 19-23; Specification, page 31, lines 18-23; Specification, page 32, lines 3-7; Figure 2, step 202. The technical framework further comprises the step of mapping of the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, and the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities. Specification, page 23, line 22 – page 24, line 5; Specification, page 24, lines 9-16; Specification, page 30, lines 13-16; Specification, page 32, lines 12-23; Figure 2, step 204; Figure 3, elements 301, 308. The technical framework further comprises the step of a list of design objects created as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components. Specification, page 33, lines 1-4; Specification, page 33, line 16 – page 34, line 2; Figure 2, step 205. The technical framework further comprises the step of designated relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer. Specification, page 33, lines 1-7; Figure 2, step 205. The technical framework further comprises the step of a detailed technical design developed for the information technology services for the customer based on tool selection criteria that are dependent upon the list of design objects and the designated relationships between the design objects. Specification, page 34, line 18 – page 35, line 13; Figure 2, step 207.

Independent Claim 24:

In one embodiment of the present invention, a computer program product for storage on a computer readable medium and operable for creating a technical framework for use and delivering a specific set of information technology services for a customer, comprising the program step of determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services. Specification, page 30, lines 19-23; Specification, page 31, lines 18-23; Specification, page 32, lines 3-7; Specification, page 36, line 20- page 37, line 9; Figure 2, step 202. The computer program product further comprises the program step of mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, and the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities. Specification, page 23, line 22 – page 24, line 5; Specification, page 24, lines 9-16; Specification, page 30, lines 13-16; Specification, page 32, lines 12-23; Specification, page 36, line 20- page 37, line 9; Figure 2, step 204; Figure 3, elements 301, 308. The computer program product further comprises the program step of creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components. Specification, page 33, lines 1-4; Specification, page 33, line 16 – page 34, line 2; Specification, page 36, line 20- page 37, line 9; Figure 2, step 205. The computer program product further comprises the program step of designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer. Specification, page 33, lines 1-7; Specification, page 36, line 20- page 37, line 9; Figure 2, step 205.

Independent Claim 25:

In one embodiment of the present invention, a data processing system operable for creating a technical framework for use in delivering a specific set of information technology services for a customer, comprising a processor. Specification, page 30, lines 19-23; Specification, page 31, lines 18-23; Specification, page 36, lines 4-6; Figure 18, element 1810. The data processing system further comprises an input device. Specification, page 36, lines 15-16, 18-20; Figure 18, elements 1824, 1826. The data processing system further comprises an output device. Specification, page 36, lines 16-20; Figure 18, elements 1828, 1838. The data processing system further comprises a memory unit. Specification, page 36, lines 6-10; Figure 18, elements 1814, 1816. The data processing system further comprises a bus system for coupling the processor to the input device, output device, and memory unit. Specification, page 36, lines 4-6; Figure 18, element 1812. The processor comprises circuitry for determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services. Specification, page 32, lines 3-7; Figure 2, step 202. The processor further comprises circuitry for mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, and the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities. Specification, page 23, line 22 – page 24, line 5; Specification, page 24, lines 9-16; Specification, page 30, lines 13-16; Specification, page 32, lines 12-23; Figure 2, step 204; Figure 3, elements 301, 308. The processor further comprises circuitry for creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components. Specification, page 33, lines 1-4; Specification, page 33, line

16 – page 34, line 2; Figure 2, step 205. The processor further comprises circuitry for designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer. Specification, page 33, lines 1-7; Figure 2, step 205.

VI. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 22-24 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

B. Claims 22-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 1-23 of co-pending Application No. 09/875,863 and over claims 25-30 of co-pending Application No. 09/875,865.

C. Claims 22-25 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hill et al. (U.S. Patent No. 6,670,973) (hereinafter "Hill").

VII. ARGUMENT

A. Claims 22-24 are not properly rejected under 35 U.S.C. §101.

The Examiner has rejected claims 22-24 under 35 U.S.C. §101 because the claimed invention allegedly is directed to non-statutory subject matter. Office Action (1/11/2007), page 4. In particular, the Examiner rejects claims 22-24 under 35 U.S.C. §101 because they do not claim a practical application with a useful, concrete and tangible result. *Id.* Further, the Examiner rejects claims 22-24 under 35 U.S.C. §101 because claims 22-24 are allegedly claiming an intangible software program. *Id.* Appellants respectfully traverse.

The Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. M.P.E.P. §2106. The subject matter courts have found to be outside the four statutory categories is limited to subject matter that is not a

practical application or use of an idea, a law of nature or a natural phenomenon. *See, e.g., Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874); M.P.E.P. §2106. Claim 22 is directed to a method, which is not outside the four statutory categories, for creating a technical framework for use in delivering a specific set of information technology services for a customer. Claim 23 is directed to a technical framework, which is not outside the four statutory categories, for use in delivering a specific set of information technology services for a customer. Claim 24 is directed to a computer program product for storage on a computer readable medium, which is not outside the four statutory categories, for creating a technical framework for use in delivering a specific set of information technology services for a customer. Creating a technical framework for use in delivering a specific set of information technology services for a customer, as recited in claims 22-24, is used to provide a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next (see page 3, line 11- page 4, line 3 of Appellants' Specification), which is a useful and concrete and tangible result.

Appellants respectfully contend that the claimed inventions in claims 22-24 satisfy the test for statutory subject matter recited in *In re Alappat*, and repeated in *State Street Bank & Trust Co. v. Signature Financial Group*, and *AT&T Corp. v. Excel Communications, Inc.* *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1526, 50 U.S.P.Q.2d 1547 (Fed. Cir. 1999). The claimed inventions produce a useful, concrete and tangible result in, *inter alia*, creating a technical framework for use in delivering a specific set of information technology services for a customer which is used to provide a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next.

The essential inquiry under *In re Alappat* is to determine whether the claimed subject matter as a whole is directed to a disembodied mathematical concept

representing nothing more than a "law of nature" or an "abstract idea" or if, in contrast, the mathematical concept has been reduced to some practical application rendering it useful. *AT&T Corp.*, 172 F.2d at 1357, 50 U.S.P.Q.2d at 1451 (citing *In re Alappat*, 33 F.3d at 1543, 31 U.S.P.Q.2d at 1556-57). Moreover, in making the determination whether the claimed subject matter as a whole is a disembodied mathematical concept or if the concept has been reduced to some practical application rendering it useful, the claims must be construed in the light of the Specification. *See, AT&T Corp.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451 (stating that more than an abstract idea was claimed in *In re Alappat* because the "claimed invention as whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a *smooth wave form display*") (emphasis supplied). The single claim at issue in *In re Alappat* was directed to a rasterizer and recited elements in means plus function form. *In re Alappat*, 33 F.3d at 1540, 31 U.S.P.Q.2d at 1555. Additionally, none of the limitations recited in the claim at issue expressly claimed a "smooth wave form display". Indeed, the concrete, useful and tangible result relied upon in *In re Alappat*, namely, a smooth uniform display, appears in the background of the invention. *Kuriappan P. Alappat, et al.*, U.S. Patent No. 5,440,676 (col. 1, lines 9-10).

Likewise, in *AT&T Corp.*, the useful, nonabstract result relied upon in holding that the claimed invention was directed to statutory subject matter was that the PIC indicator therein held information about the call recipients PIC, which facilitated differential billing of long-distance calls made by a subscriber. *AT&T Corp.*, 172 F.3d 1358, 50 U.S.P.Q.2d at 1452. However, the claim at issue in *AT&T Corp.* was directed to a method including the steps of generating a message record for an interexchange call, and including in the message record a PIC indicator having a value which is a function of whether or not the interexchange carrier associated with the terminating subscriber is a predetermined one of the interexchange carriers. *AT&T Corp.*, 172 F.3d at 1354, 50 U.S.P.Q.2d at 1449. Again, there was no express or explicit claim limitation directed to the useful, concrete, and tangible result relied



upon in determining that the aforesaid claim was directed to statutory subject matter. *See, Id.* The relied upon PIC indicator that facilitates differential billing of long-distance calls appears, *inter alia*, in the summary of the invention. *Gerard P. Doherty, et al.*, U.S. Patent No. 5,333,184, col. 1, line 66 through col. 2, line 3.

Likewise, in *State Street Bank & Trust v. Signature Financial Group*, a useful and concrete and tangible result not expressed in an explicit limitation in the claim at issue was relied upon in holding that the claim was directed to statutory subject matter. *See, State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601 (holding that the transformation of data by the claimed data processing system produced a useful, concrete and tangible result, namely a final share price momentarily fixed for recording and reporting purposes). The claimed invention recited no limitation directed to either a final share price or means for momentarily fixing the final share price for recording and reporting purposes. *See, State Street Bank*, 149 F.3d at 1371, 47 U.S.P.Q.2d at 1599. Indeed, the relied upon useful, concrete and tangible result in *State Street Bank*, namely a final share price momentarily fixed, is not explicitly recited in the *State Street Bank* patent, but is effectively a distillation of the Summary of the Invention. *See, R. Todd Boes*, U.S. Patent No. 5,193,056, col. 4, lines 36-61. Thus, it is beyond peradventure that when judging the claimed subject matter as a whole to determine patentability under 35 U.S.C. § 101, the claims must be construed in the light of the specification.

In construing the claims in light of the specification, claims 22-24 clearly do produce a useful, tangible result. For example, referring to claim 22, claim 22 is directed to a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, which includes the steps of: determining a solution scope for the technical framework to be created...; mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model...; creating a list of design objects as a function of the solution scope for the technical framework...; designating relationships between the design objects as a function of the solution scope.... These

are steps that are directed to creating a technical framework for use in delivering a specific set of information technology services for a customer. Creating a technical framework for use in delivering a specific set of information technology services for a customer is used to provide a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next (see page 3, line 11- page 4, line 3 of Appellants' Specification), which is a useful and concrete and tangible result.

Claims 23 and 24 are similarly directed to a useful, tangible, result, namely creating a technical framework for use in delivering a specific set of information technology services for a customer which is used to provide a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next (see page 3, line 11- page 4, line 3 of Appellants' Specification).

As stated above, the inquiry under 35 U.S.C. §101 is whether there is a practical application, or result. *State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601. As discussed above, claims 22-24 are directed to a useful, tangible, result. Hence, the subject matter of claims 22-24 has a practical application within the four statutory categories and is not an idea, a law of nature or a natural phenomenon.

Thus, Appellants respectfully contend that claims 22-24 constitute statutory subject matter. Appellants respectfully assert that the rejections of claims 22-24 under 35 U.S.C. §101 are in error.

Furthermore, the Examiner appears to contend that claims 22-24 are directed to non-statutory subject matter because they do not recite a data processing system. The Examiner has not provided any basis to support such a proposition except citing to M.P.E.P. §2106(IV)(C) which does not provide any support for the assertion that claims 22-24 are directed to non-statutory subject matter. Neither has the Examiner provided any basis to support the assertion that a computer program product is non-statutory subject matter despite the fact that the United States and the Federal Circuit

have issued numerous opinions (e.g., *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)) stating that claims directed to a computer program product are statutory. Appellants kindly request the Examiner to cite case law to support the Examiner's assertion that claims 22-24 are not directed to statutory subject matter in the Examiner's Answer.

B. Claims 22-25 are not properly rejected under obviousness-type double patenting.

The Examiner has provisionally rejected claims 22-25 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-23 of co-pending Application No. 09/875,863. Office Action (1/11/2007), page 5. Further, the Examiner has provisionally rejected claims 22-25 under the judicially created doctrine of obviousness-type double patenting in view of claims 25-30 of co-pending Application No. 09/875,865. Office Action (1/11/2007), page 6. Appellants respectfully traverse.

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? M.P.E.P. §804. A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the non-obviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (C.C.P.A. 1967); M.P.E.P. §804. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966),

that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. M.P.E.P. §804. However, the Examiner has not made any such inquiry. The Examiner has not made any factual inquiries (1) to determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) to determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue; (3) to determine the level of ordinary skill in the art; and (4) to evaluate any objective indicia of non-obviousness. M.P.E.P. §804. Any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application. M.P.E.P. §804. Further, any obviousness-type double patenting rejection should include reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. §804. The Examiner has not made clear the differences between the inventions claimed in the application and the claims in the cited patent applications. Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of claims 22-25. Thus, the rejections of claims 22-25 under obviousness-type double patenting are improper.

C. Claims 22-25 are not properly rejected under 35 U.S.C. §102(e) as being anticipated by Hill.

The Examiner has rejected claims 22-25 under 35 U.S.C. §102(e) as being anticipated by Hill. Office Action (1/11/2007), page 7. Appellants respectfully traverse these rejections for at least the reasons stated below.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Appellants respectfully assert that Hill does not disclose "determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 1, line 53 – column 2, line 10; and column 3, lines 10-65 of Hill as disclosing the above-cited claim limitations. Office Action (1/11/2007), page 7. Appellants respectfully traverse.

Hill instead discloses a method performed on a computer for representing the information technology infrastructure of an organization which includes storing data representing information technology elements of an organization, organizational elements of the organization, and relationships between the information technology elements and the organizational elements. Column 1, lines 53-59. Hill further discloses that to generate hierarchical list 62 and hierarchical graph 54, processing device 22 includes a processor 24 and a memory 26. Column 3, lines 9-11. Hill additionally discloses that memory 26 stores representations of the information technology elements of the organization, the organizational elements of the organization, and the relationships between the information technology elements and the organizational elements. Column 3, lines 11-15.

There is no language in the cited passages that discloses determining a solution scope for the technical framework to be created. Neither is there any language in the cited passages that discloses that the solution scope is guided by an information technology services contract with the customer. Neither is there any language in the cited passages that discloses that the solution scope is based on common practices for delivering certain types of information technology services. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

In response to Appellants' above argument, the Examiner simply asserts that

the limitations are interpreted as the teachings in Hills. Office Action (1/11/2007), pages 2-3. Appellants respectfully traverse such interpretations. The pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 22-25. M.P.E.P. §2111.

Appellants further assert that Hill does not disclose "mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 4, lines 35-55; column 6, line 64 – column 7, line 10; and column 9, lines 1-55 of Hill as disclosing the above-cited claim limitations. Office Action (1/11/2007), page 7. Appellants respectfully traverse.

Hill instead discloses an example of one of data files 48 stored in database 46 for use in system 10. Column 4, lines 38-39. Hill further discloses that section 61 presents hierarchical list 62, which is illustrated as a tree diagram. Column 6, lines 64-65. Hill additionally discloses that hierarchical graph 54 corresponds with hierarchical list 62 in interactive user interface 60. Column 9, lines 15-16.

There is no language in the cited passages that discloses mapping the customer's existing equipment to lowest level abstractions of architectural building

blocks in a technical model. Neither is there any language in the cited passages that discloses that the technical model describes people, processes, tools and information used to deliver specific services to customers. Neither is there any language in the cited passages that discloses that the architectural building blocks comprise architectural components that are sufficiently modular and bounded to be described as self-contained entities. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

In response to Appellants' above argument, the Examiner simply asserts that the limitations are interpreted as the teachings in Hills. Office Action (1/11/2007), page 3. Appellants respectfully traverse such interpretations. The pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 22-25. M.P.E.P. §2111.

Appellants further assert that Hill does not disclose "creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 3, line 24 – column 4, line 35 and column 9, lines 1-55 of Hill as disclosing the above-cited claim limitation. Office Action (1/11/2007), page 8. Appellants respectfully traverse and assert that Hill instead discloses that in operation, data collection module 32, data importation module 34, and /or data entry module 36 allow computer program 42 to obtain data that represents the information technology elements, the organizational elements, and the relationships between

them. Column 3, lines 35-39. Hill additionally discloses that hierarchical graph 54 corresponds with hierarchical list 62 in interactive user interface 60. Column 9, lines 15-16. There is no language in the cited passages that discloses creating a list of design objects. Neither is there any language in the cited passages that discloses creating a list of design objects as a function of the solution scope for the technical framework. Neither is there any language in the cited passages that discloses that the design objects are based on logical groupings of architectural building blocks. Neither is there any language in the cited passages that discloses that the design objects are based on logical groupings of architectural building blocks, including software and hardware components. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

In response to Appellants' above argument, the Examiner simply asserts that the limitations are interpreted as the teachings in Hills. Office Action (1/11/2007), pages 3-4. Appellants respectfully traverse such interpretations. The pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 22-25. M.P.E.P. §2111.

Appellants further assert that Hill does not disclose "designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 4, lines 1-7 of Hill as disclosing the above-cited claim limitation. Office Action (1/11/2007), page 8. Appellants respectfully traverse and assert that Hill instead discloses that interactive user



interface 60 allows a user of computer 42 to modify the relationships between the information technology elements and the organizational elements, as well as the elements themselves. Column 4, lines 4-7. There is no language in the cited passage that discloses designating relationships between the design objects and the specific set of information technology services. Neither is there any language in the cited passage that discloses designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

VIII. CONCLUSION

For the reasons noted above, the rejections of claims 22-25 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 22-25.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Appellants

By: 

Robert A. Voigt, Jr.  
Reg. No. 47,159

P.O. Box 50784  
Dallas, Texas 75201  
(512) 370-2832

**CLAIMS APPENDIX**

22. A method for creating a technical framework for use in delivering a specific set of information technology services for a customer, comprising the steps of:

determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services;

mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities;

creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components; and

designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer.

23. A technical framework for use in delivering a specific set of information technology services for a customer, comprising the steps of:

a solution scope determined for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services;

a mapping of the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, and the architectural building blocks comprising architectural components

that are sufficiently modular and bounded to be described as self-contained entities;

a list of design objects created as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components;

designated relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer; and

a detailed technical design developed for the information technology services for the customer based on tool selection criteria that are dependent upon the list of design objects and the designated relationships between the design objects.

24. A computer program product for storage on a computer readable medium and operable for creating a technical framework for use and delivering a specific set of information technology services for a customer, comprising the program steps of:

determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services;

mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, and the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities;

creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components; and

designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer.

25. A data processing system operable for creating a technical framework for use in delivering a specific set of information technology services for a customer, comprising:

- a processor;
- an input device;
- an output device;
- a memory unit; and

a bus system for coupling the processor to the input device, output device, and memory unit, the processor further comprising:

- circuitry for determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services;

- circuitry for mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, and the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities;

- circuitry for creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components; and

- circuitry for designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer.

**EVIDENCE APPENDIX**

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

**RELATED PROCEEDINGS APPENDIX**

There are no related proceedings to the current proceeding.

Austin\_1 504047v.1